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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,436	06/25/2003	Steven M. Burns	085.10940-US (03-325)	6928
34704 7590 06/11/2009 BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510			EXAMINER IP, SIKYIN	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 06/11/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. BURNS and STEVEN P. HAHN

Appeal 2008-004945
Application 10/606,436
Technology Center 1700

Decided:¹ June 11, 2009

Before EDWARD C. KIMLIN, LINDA M. GAUDETTE, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of our Decision of February 20, 2009
("Decision"), wherein we sustained the Examiner's rejection of the

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

appealed claims under 35 U.S.C. § 103(a).

We have carefully considered the arguments set forth in Appellants' Request, but we remain of the opinion that the Examiner drew the proper legal conclusion that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103.

Appellants submit that we misapprehended their argument with respect to Burns not teaching a diffusion heat treating step. However, Appellants expressly state in their Reply Brief that "there is nothing here [in Burns] which teaches a diffusion heat treating step" (Reply Br. 3, first para.). As set forth in our Decision, Burns provides a specific teaching of such and Appellants' Request does not dispute this.

As for the claim recitation "gas being injected at a workpiece center location", Appellants submit that "there is one, and only one, interpretation of the phrase" (Request 4, second para.). However, while there is only one center of the workpiece, the claimed step of injecting the gas can be performed in a variety of ways such that the gas impinges other areas of the workpiece and at the center location from a variety of angles. We note that Appellants do not dispute our finding that the appealed claims are sufficiently broad to encompass injecting gas at the entirety of the workpiece, including its center location. Appellants have not refuted our rationale that it would have been obvious for one of ordinary skill in the art to inject gas at the entirety of Burns's workpiece during the diffusion heat treating step and, thereby, perform the claimed step of injecting gas at a workpiece center location. Nor have Appellants submitted any reason why the diffusion heat treating step of Burns would not result in gas being injected at the center of the workpiece.

Appellants also contend that we have erroneously ignored the factual and objective evidence of unexpected results represented by Figures 3 and 4 of the present Specification. In response to our statement in the Decision that Appellants have not presented the requisite analysis of the Specification Figures, and “[i]t is not for this Board to ferret out factual data in the record and interpret it in a light most favorable to the applicant” (Decision 5, third para.), Appellants maintain that “the differences in coatings are clear from a mere viewing of Figures 3 and 4 – no explanation is required” (Request 6, emphasis added). However, it is fundamental that the burden of demonstrating unexpected results rests on the party asserting them,² and that Appellants must demonstrate that the evidence is reasonably commensurate in scope with the degree of protection sought by the appealed claims,³ that the evidence presents a comparison with the closest prior art,⁴ and that the evidence would have been considered truly unexpected by one of ordinary skill in the art.⁵ Manifestly, Appellants have not carried their burden on this record.

In conclusion, based on the foregoing, Appellants’ Request to reconsider our Decision has been granted, but is denied with respect to making any change therein.

DENIED

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2008).

² *In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972).

³ *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983).

⁴ *In re Johnson*, 747 F.2d 1456, 1461 (Fed. Cir. 1984).

⁵ *In re Merck & Co.*, 800 F.2d 1091, 1098-99 (Fed. Cir. 1986).

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